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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/626,343	07/24/2003	Robert G. Marsico	18587-7	9149
21130 7590 06/29/2007 BENESCH, FRIEDLANDER, COPLAN & ARONOFF LLP ATTN: IP DEPARTMENT DOCKET CLERK 2300 BP TOWER 200 PUBLIC SQUARE CLEVELAND, OH 44114			EXAMINER SCHEIBEL, ROBERT C	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/626,343

Applicant(s)

MARSICO ET AL.

Examiner

Robert C. Scheibel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities:

- In the last line in paragraph 0028 on page 7, the word “fro” should be corrected to “from”.

Appropriate correction is required.

Claim Objections

2. Claim 11 is objected to because of the following informalities:

- “manageable” on line 2 is misspelled and should be corrected to “manageable”.
- The claim is for a “network device” which communicates with a network of more “network devices”; these are not adequately distinguished in the claim language. The claim must be amended to clarify these differences. For example, in lines 2-3, “selected network devices” must be changed to distinguish them from “a network device” of line 1. Similarly, “a network device” on line 5 is different than that of line 1 and must be amended to clarify. All such instances must be addressed.

Appropriate correction is required.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

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improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1, 11, 14, and 19 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 10, and 12 of U.S. Patent 7,171,194.

Although the conflicting claims are not identical, they are not patentably distinct from each other for the reasons stated below.

Regarding claim 1, claim 1 of U.S. Patent 7,171,194 discloses a network comprising: a plurality of network devices configured to have a common address identifying the network (see the preamble of claim 1; this is a narrower version of the common address limitation), and an uncommon address within the network where the uncommon address identifies particular network devices (see the unique identifier limitation of claim 1); a computer-readable medium configured to store a profile, each profile configured to include at least one record corresponding to at least one of the plurality of network devices, the record including the uncommon address associated with the at least one of the network devices (see the computer-readable medium of claim 1); and logic configured to manage the network including changing the record to correlate

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services available to the network with particular network devices via the uncommon address (see the limitation of the change request of claim 1; clearly, if the change request is to be implemented, the logic to change the record must be present).

However, claim 1 of U.S. Patent 7,171,194 does not disclose expressly the limitation that the profile is associated with the common identifier. U.S. Patent 7,155,226 to Oh et al discloses this limitation in Figure 4. At the time of the invention, it would have been obvious to modify claim 1 of U.S. Patent 7,171,194 to associate the profile with the common telephone number for the benefit of efficiently managing information associated with the common telephone number.

Regarding claim 11, claim 10 of U.S. Patent 7,171,194 discloses a network device configured for communication with a network that includes a user manageable database correlating identifiable communications to selected network devices, the network device comprising: a computer-readable medium configured to store an uncommon address uniquely identifying a network device on a network identifiable by a common address (see the computer-readable medium limitation of claim 10); and logic configured to format a signaling word including the uncommon address, and payload data representative of a change request to manage routing of subsequent communications directed generally to the network, to particular network devices (see the "logic configured to format" limitation of claim 10).

Regarding claims 14 and 19, claim 12 of U.S. Patent 7,171,194 discloses a method of subscriber management of a network of devices comprising: receiving an inbound signaling word from a subscriber including management data corresponding to a network identifiable by a common address and corresponding to a network device identifiable by an uncommon address

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(see the receiving step of claim 12); and modifying a computer-readable medium to reflect desired services relative to the network device (see the correlating step of claim 12).

5. Claims **1, 14, and 19** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 11/668,247. Although the conflicting claims are not identical, they are not patentably distinct from each other for the reasons stated below.

Regarding claim **1**, claim 1 of copending Application No. 11/668,247 discloses a network comprising: a plurality of network devices configured to have a common address identifying the network (the common phone number of claim 1), and an uncommon address within the network where the uncommon address identifies particular network devices (see the unique identifier limitation of claim 1); and logic configured to manage the network including changing the record to correlate services available to the network with particular network devices via the uncommon address (see the limitation to generate the change request of claim 1; clearly, if the change request is to be implemented or useful, the logic to change the record must be present).

Regarding claims **14 and 19**, claim 1 of copending Application No. 11/668,247 discloses a method of subscriber management of a network of devices comprising: receiving an inbound signaling word from a subscriber including management data corresponding to a network identifiable by a common address and corresponding to a network device identifiable by an uncommon address (while the receiving of the change request is not explicitly claimed, it is implied by the generation step).

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However, claim 1 of copending Application No. 11/668,247 does not disclose expressly the limitation of the profile stored in a computer-readable medium of claim 1, the explicit step of receiving the change request of claims 14 and 19, or the step of modifying the computer-readable medium of claims 14 and 19. U.S. Patent 7,155,226 to Oh et al discloses the profile limitation in Figure 4 (see the rejection below for more detail). Oh also discloses the limitation of receiving the change request and then modifying the computer-readable medium in the registration requests of Figure 5 and the corresponding description in lines 4-51 of column 9 as well as steps 70, 76, and 82 of Figure 5 (again, see the rejection below for more detail). At the time of the invention, it would have been obvious to modify claim 1 of copending Application No. 11/668,247 to associate the profile with the common telephone number for the benefit of efficiently managing information associated with the common telephone number. It would also have been obvious to implement the change request by receiving it and using it to actually change a profile; without these steps, the change request has not utility.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Claim 11 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 12 of copending Application No. 10/779,270. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons.

Regarding claim 11, claim 12 of copending Application No. 10/779,270 discloses a network device configured for communication with a network that includes a user manageable

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database correlating identifiable communications to selected network devices, the network device comprising: a computer-readable medium configured to store an uncommon address uniquely identifying a network device on a network identifiable by a common address (see the computer-readable medium limitation of claim 12); and logic configured to format a signaling word including the uncommon address, and payload data representative of a change request to manage routing of subsequent communications directed generally to the network, to particular network devices (see the “logic configured to format” limitation of claim 12).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 19-22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are drawn toward “an article of manufacture...”. However, it is clear from the context of the claims that the “article of manufacture” is nothing more than software code as it comprises merely computer executable instructions. Software, or any type of “functional descriptive material”, is not statutory when claimed as descriptive material, per se. See pages 50-57 of “Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility”.

In one sense, this *specific* rejection can be overcome by modifying the claim to read “A computer-readable medium comprising an article of manufacture...” as this would not be

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claiming the software, per se. However, this claim would be subject to a similar rejection under 35 U.S.C. 101 as the specification has defined a computer-readable medium to include signals which are not statutory subject matter.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims **1-8 and 10-22** are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 7,155,226 to Oh et al.

Regarding claim 1, Oh discloses a network comprising: a plurality of network devices (the mobile stations 14, 16, and 18) configured to have a common address identifying the network (the common MIN discussed throughout – see lines 54-61 of column 1 and the common MIN of Figure 4, for example), and an uncommon address within the network where the uncommon address identifies particular network devices (the unique ESNs for each phone – see figure 4); a computer-readable medium configured to store a profile associated with the common address, each profile configured to include at least one record corresponding to at least one of the plurality of network devices, the record including the uncommon address associated with the at least one of the network devices (the subscriber profile database 42 of Figure 2 stores the subscriber profile 102 of Figure 4); and logic configured to manage the network including

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changing the record to correlate services available to the network with particular network devices via the uncommon address (see figure 5 and the corresponding description in lines 4-51 of column 9).

Regarding claim 11, Oh discloses a network device (controller logic 20 and controller 40 of Figure 2) configured for communication with a network that includes a user manageable database (subscriber profile database 42 of figure 2) correlating identifiable communications to selected network devices, the network device comprising: a computer-readable medium configured to store an uncommon address uniquely identifying a network device on a network identifiable by a common address (the controller 40 stores the ESN row in the MIN table of Figure 4); and logic configured to format a signaling word including the uncommon address, and payload data representative of a change request to manage routing of subsequent communications directed generally to the network, to particular network devices (this is disclosed by the acknowledgement signal of lines 23-25 of column 9, for example; the signal is addressed to the mobile station and thus includes the ESN and the success or failure it represents is representative of a change request (adding the ESN to the MIN table) to manage subsequent routing of communications).

Regarding claim 14, Oh discloses a method of subscriber management of a network of devices comprising: receiving an inbound signaling word from a subscriber including management data corresponding to a network identifiable by a common address and corresponding to a network device identifiable by an uncommon address (the registration requests of Figure 5 and the corresponding description in lines 4-51 of column 9); and modifying

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a computer-readable medium to reflect desired services relative to the network device (steps 70, 76, and 82 of Figure 5).

Similarly, regarding claim 19, Oh discloses an article of manufacture embodied in a computer-readable medium for managing a network of identifiable devices, the article of manufacture comprising: first computer executable instructions (lines 3-6 of column 8 clearly indicates that the controller can be implemented using software) for causing a computer to parse an incoming signaling word for indicia identifying a network and indicia identifying an individual device within the network (step 68 of Figure 5 which parses the MIN and ESN for the registration message); and second computer executable instructions for causing a computer to modify a record associated with the individual device based on payload data in the incoming signaling word, where the payload data is configured to alter services available to the individual device (steps 70, 76, and 82 of Figure 5).

Regarding claim 2, Oh discloses the limitation that the computer-readable medium is configured to associate services to selected network devices in lines 62-67 of column 6 which indicates that the service provider must also track whether the mobile station will respond to a MIN-based termination message which is indicative of the type of service associated with that device.

Regarding claim 3, Oh discloses the limitation of access logic configured to control access to the computer-readable medium configured to store profiles in the authentication described in lines 13-18 of column 9.

Regarding claim 4, Oh discloses the limitation that the access logic is configured, to receive data from a network device representing a change to be made to the computer-readable

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medium, and selectively permit at least a portion of the data to pass to the computer-readable medium in figure 5 and the corresponding description in lines 4-51 of column 9 which describes the registration message (data from the network device) which represents a change to the computer-readable medium (adding the ESN to the MIN table, for example) and is selectively allowed to pass based on the results of the authentication described above.

Regarding claim 5, Oh discloses the limitation that the access logic is configured to receive data from other than a network device representing a change to be made to the computer-readable medium, and selectively permit at least a portion of the data to pass to the computer-readable medium from line 66 of column 7 through line 6 of column 8 which indicates that the data may come from a computer terminal at which an administrator entered the data.

Regarding claim 6, Oh discloses the limitation that the common address comprises a telephone number and the uncommon address comprises an electronic serial number in Figure 4 – the MIN is a telephone number and the ESN is an electronic serial number.

Regarding claim 7, Oh discloses the limitation that the common address comprises user account information in that the MIN is the number assigned to that user/device; see lines 20-24 of column 1, for example, which indicates that it is used for billing the subscriber.

Regarding claim 8, Oh discloses the limitation that the profile is configured to associate a at least one network device and at least one identifiably distinct network service (see lines 62-67 of column 6; only one device is allowed to respond to termination messages (see lines 35-40 of column 5, for example) and this distinct service is stored as indicated in lines 62-67 of column 6).

Regarding claim 10, Oh discloses the limitation of logic configured to provide a service to a particular network device by comparing the records with a detectable attribute of the service in lines 43-67 of column 6 which indicates that a service (registration) is denied by comparing the records regarding the ESNs already registered for the MIN.

Regarding claim 12, Oh discloses the limitation of transceiver logic configured to transmit the signaling word to the network in lines 23-25 of column 9 which requires transceiver logic to send the message to the mobile device.

Regarding claim 13, Oh discloses the limitation of a trigger configured to initiate the change request upon a designated occurrence (see lines 4-11 of column 9 which indicate that the change request is sent when the device is powered on).

Regarding claim 15, Oh discloses the limitations of preparing the inbound signaling word including payload data representative of desired services corresponding to identifiable network devices (see lines 4-11 of column 9; the registration message indicates that the user wishes to register for services on the network); appending the common address to the inbound signaling word (the MIN of line 10 of column 9); and transmitting the inbound signaling word to a service provider network (lines 8-11 of column 9).

Regarding claim 16, Oh discloses the limitations of accessing a profile associated with the common address; within the accessed profile, accessing a record associated with the uncommon address; and designating availability of a service to a device associated with the accessed record (see figures 4 and 5; the MIN profile is clearly associated with the common address and the ESN row is associated with the uncommon address and the type and state fields designate the availability of a service to the device).

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Regarding claim 17, Oh discloses the limitation of verifying propriety of the inbound signaling word in the authentication described in lines 13-18 of column 9.

Regarding claim 18, Oh discloses the limitations of receiving service data directed to the common address (step 90 of Figure 7); determining an uncommon address identifying a device designated to receive the service data based on attributes of the service data (step 92 of Figure 7); and providing the service data to the device via the uncommon address (steps 94-108 of Figure 7).

Regarding claim 20, Oh discloses the limitation of third computer executable instructions for causing a computer to generate an outbound signaling word directed to at least one device within the network responsive to the modification of the record in the acknowledgement signal of lines 23-25 of column 9, for example.

Regarding claim 21, Oh discloses the limitations of fourth computer executable instructions for causing a computer to parse incoming data for a network identifying indicia and to select a profile based on the network identifying indicia (step 90 of Figure 7); and fifth computer executable instructions for causing a computer to determine at least one device in the network designated to receive the incoming data based on content of the incoming data and records in the profile (step 92 of Figure 7).

Regarding claim 22, Oh discloses the limitation of sixth computer executable instructions for causing a computer to provide the incoming data to the at least one device (steps 94-108 of Figure 7).

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10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 7,155,226 to Oh et al in view of U.S. Patent Application Publication 2003/0125072 to Dent.

Oh discloses all the limitations of parent claim 1 as described in the rejection under 35 U.S.C. 102(e) above. However, Oh does not disclose expressly the limitation of a network device including a plurality of common addresses identifying a plurality of networks.

Dent discloses the limitation of a network device including a plurality of common addresses identifying a plurality of networks in paragraph 39 on page 4. Oh and Dent are analogous art because they are from the same field of endeavor of mobile communications. At the time of the invention it would have been obvious to a person of ordinary skill in the art to modify Oh to allow devices to belong to more than one common address group. The motivation for doing so would have been to allow one particular user device to be associated with more than

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one telephone number depending upon the profile stored in the database. Therefore, it would have been obvious to combine Dent with Oh for the benefit of allowing one user device to be associated with multiple telephone numbers to obtain the invention as specified in claim 9.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- U.S. Patent 7,162,020 to Forte discloses a method for selectively establishing communication with one of plural devices associated with a single telephone number.
- U.S. Patent 6,449,483 to Akhteruzzaman et al discloses a wireless telephone system for accessing multiple stations via a single telephone number.
- U.S. Patent Application Publication 2003/0039238 to Ollis et al discloses an architecture for linking multiple internet protocol telephony devices having a common telephone number
- U.S. Patent 6,775,546 to Fuller discloses a mobile telephone system.
- U.S. Patent Application Publication 2003/0186676 to Ogman et al discloses a method for sharing cellular communication services among mobile stations of different networks.
- U.S. Patent Application Publication 2001/0043694 to Chartrand discloses a method for routing calls to multi-function telephone numbers.
- U.S. Patent Application Publication 2001/00230187 to Wilhelm discloses devices for forming terminal groups in a mobile network.

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- U.S. Patent Application Publication 2002/0110098 to Bunn et al discloses a method for multiplexing wireless devices.
- U.S. Patent 6,944,476 to Alschul et al discloses a wireless telephonic system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert C. Scheibel whose telephone number is 571-272-3169. The examiner can normally be reached on Monday and Thursday from 6:30-5:00 Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wing F. Chan can be reached on 571-272-7493. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RCS 6-25-07
Robert C. Scheibel
Patent Examiner
Art Unit 2616

Wing F. Chan
6/25/07

WING CHAN
SUPERVISORY PATENT EXAMINER